

EXHIBIT 4



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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
90/007,913	02/01/2006	6284478	518852800200	5776

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 P.O. BOX 2903
 MINNEAPOLIS, MN 55402-0903

MD

EXAMINER

ART UNIT PAPER NUMBER

DATE MAILED: 02/24/2006

Owner's Statement
 Apr 24, 2006
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Please find below and/or attached an Office communication concerning this application or proceeding.



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***EX PARTE* REEXAMINATION COMMUNICATION TRANSMITTAL FORM**

REEXAMINATION CONTROL NO. 90/007,913.

PATENT NO. 6284478.

ART UNIT 3991.

Enclosed is a copy of the latest communication from the United States Patent and Trademark Office in the above identified *ex parte* reexamination proceeding (37 CFR 1.550(f)).

Where this copy is supplied after the reply by requester, 37 CFR 1.535, or the time for filing a reply has passed, no submission on behalf of the *ex parte* reexamination requester will be acknowledged or considered (37 CFR 1.550(g)).

Order Granting / Denying Request For Ex Parte Reexamination	Control No.	Patent Under Reexamination	
	90/007,913	6284478	
	Examiner	Art Unit	
	Evelyn Huang	3991	

--The MAILING DATE of this communication appears on the cover sheet with the correspondence address--

The request for *ex parte* reexamination filed 01 February 2006 has been considered and a determination has been made. An identification of the claims, the references relied upon, and the rationale supporting the determination are attached.

Attachments: a) ☒ PTO-892, b) ☐ PTO-1449, c) ☐ Other: _____

1. ☒ The request for *ex parte* reexamination is GRANTED.

RESPONSE TIMES ARE SET AS FOLLOWS:

For Patent Owner's Statement (Optional): TWO MONTHS from the mailing date of this communication (37 CFR 1.530 (b)). **EXTENSIONS OF TIME ARE GOVERNED BY 37 CFR 1.550(c).**

For Requester's Reply (optional): TWO MONTHS from the **date of service** of any timely filed Patent Owner's Statement (37 CFR 1.535). **NO EXTENSION OF THIS TIME PERIOD IS PERMITTED.** If Patent Owner does not file a timely statement under 37 CFR 1.530(b), then no reply by requester is permitted.

2. ☐ The request for *ex parte* reexamination is DENIED.

This decision is not appealable (35 U.S.C. 303(c)). Requester may seek review by petition to the Commissioner under 37 CFR 1.181 within ONE MONTH from the mailing date of this communication (37 CFR 1.515(c)). **EXTENSION OF TIME TO FILE SUCH A PETITION UNDER 37 CFR 1.181 ARE AVAILABLE ONLY BY PETITION TO SUSPEND OR WAIVE THE REGULATIONS UNDER 37 CFR 1.183.**

In due course, a refund under 37 CFR 1.26 (c) will be made to requester:

- a) ☐ by Treasury check or,
b) ☐ by credit to Deposit Account No. _____, or
c) ☐ by credit to a credit card account, unless otherwise notified (35 U.S.C. 303(c)).

Evelyn Huang
Primary Examiner
Art Unit: 3991

cc:Requester (if third party requester)

Notice of References Cited

Application/Control No.

90/007,913

Applicant(s)/Patent Under

Reexamination

6284478

Examiner

Evelyn Huang

Art Unit

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U.S. PATENT DOCUMENTS

*		Document Number Country Code-Number-Kind Code	Date MM-YYYY	Name	Classification
*	A	US-4,986,271	01-1991	Wilkins, Ebtisam S.	600/347
	B	US-			
	C	US-			
	D	US-			
	E	US-			
	F	US-			
	G	US-			
	H	US-			
	I	US-			
	J	US-			
	K	US-			
	L	US-			
	M	US-			

FOREIGN PATENT DOCUMENTS

*		Document Number Country Code-Number-Kind Code	Date MM-YYYY	Country	Name	Classification
	N					
	O					
	P					
	Q					
	R					
	S					
	T					

NON-PATENT DOCUMENTS

*		Include as applicable: Author, Title Date, Publisher, Edition or Volume, Pertinent Pages)
*	U	Sakakida et al. Sensors and Actuators B, 13-14: 319-322 (May-June, 1993).
*	V	Sternberg et al. Biosensors, 4:27-40 (1988).
*	W	Sakakida et al. (II). Artif. Organs Today, 2(2) :145-158 (1992).
*	X	Shichiri et al. Diab. Nutr. Metab., 2:309-313 (1989).

*A copy of this reference is not being furnished with this Office action. (See MPEP § 707.05(a).)
 Dates in MM-YYYY format are publication dates. Classifications may be US or foreign.

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Reexamination

Decision Granting Ex Parte Reexamination

1. A substantial new question of patentability affecting claims 1-74 of United States Patent Number 6,284,478 to Heller is raised by the request for *ex parte* reexamination.

Procedural Posture

2. The request by the Third Party Requester for *ex parte* reexamination is filed on 2/1/2006.

Ongoing Duty to Disclose

3. A PTO-1449 has not been filed with the references submitted by the Third Party Requester. The submitted references considered by the examiner are cited in a PTO-892.
4. The patent owner is reminded of the continuing responsibility under 37 CFR 1.565(a) to apprise the Office of any litigation activity, or other prior or concurrent proceeding, involving Patent No. 6,284,478 throughout the course of this reexamination proceeding. The third party requester is also reminded of the ability to similarly apprise the Office of any such activity or proceeding throughout the course of this reexamination proceeding. See MPEP §§ 2207, 2282 and 2286.

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Priority

4. US 6,284,478, the patent under reexamination, is a continuation of US Application No. 08/299,526, filed on 9-1-1994, issued as US Patent No. 5,593,853, which is a CIP of US Application No. 08/161,682, filed on 12-2-1993, issued as US Patent No. 5,356,786, which is a continuation of US Application No. 07/664,054, filed on 3-4-1991, now abandoned.

5. US Application No. 08/161,682, filed on 12-2-1993, issued as US Patent No. 5,356,786, only describes a glucose electrode coated with an oxidizing enzyme (peroxidase) which allows hydrogen peroxide to selectively oxidize the interferants (as described in Fig. 6). The electrode of the instant invention having preferably three or four layers, including the interference eliminating layer (as described in Fig. 1), was first described in US Application No. 08/299,526, filed on 9-1-1994, issued as US Patent No. 5,593,853. Accordingly, the earliest effective filing date for the patent claims under reexamination is 9-1-1994.

References Cited by the Third Party Requester

6. ***Old References***

Wilkins US 4,986,271

Sakakida et al. (I) Sensors and Actuators B, 13-14: 319-322 (May-June, 1993).

Sternberg et al. Biosensors, 4:27-40 (1988).

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7. *New References*

Sakakida et al. (II). Artif. Organs Today, 2(2) :145-158 (1992).

Shichiri et al. Diab. Nutr. Metab., 2:309-313 (1989).

Claims in U.S. 6,284,478

8. Claims 1-3 are directed to an electrochemical sensor comprising (a) one or more non-corroding metal or carbon electrodes; (b) a sensing layer comprising an enzyme coupled to each electrode; and (c) a biocompatible layer comprising a biocompatible hydrogel chemically bound to the sensing layer of each electrode.

Claim 4 is directed to an analyte measurement system comprising (a) an electrochemical sensor including two or more non-corroding metal or carbon electrodes, each electrode adapted for subcutaneous implantation in animal, and a non-leachable analyte-responsive enzyme disposed on each of the electrodes; and (b) a device for comparing signals of the two electrodes.

Claims 5-8 are directed an electrochemical sensor comprising (a) one or more non-corroding metal or carbon electrodes; (b) a sensing layer coupled to each electrode wherein the sensing layer comprises a non-leachable redox enzyme; and (c) a microfiltration device for transporting a fluid sample into contact with the sensing layer of at least one of the electrodes.

Claims 9-51, 74 are directed to an electrochemical sensor for measuring an analyte in an animal, comprising one or more analyte responsive electrodes, at lease one electrode adapted for subcutaneous implantation in animal, each of the analyte responsive electrode comprises (a) one two or more non-corroding metal or carbon electrodes and a non-leachable analyte-responsive

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enzyme disposed on each of the electrodes; and (b) a sensing layer comprising a redox enzyme and a redox compound, which are non-leachable fluids in the body of the animal at a pH of 6.5-7.8.

Claims 52-63, 70-73 are directed to a method of calibrating an electrochemical sensor comprising (a) withdrawing a single calibration sample from an animal; (b) assaying an analyte concentration of the sample; and (c) correlating the assayed analyte concentration to a signal generated by one or more implanted working electrode having an analyte-responsive enzyme disposed thereon.

Claims 64-69 are directed to a method for the analysis of a bioanalyte comprising (a) providing an analyte measurement system comprising two or more subcutaneously implantable electrodes; (b) subcutaneously implanting 2 or more electrodes in the animal; (c) obtaining readings from the electrodes at substantially one point in time; (d) comparing two or more of the readings of the electrodes; and (e) accepting those readings which do not vary by more than a predetermined degree.

Substantial New Question of Patentability

9. For “a substantial new question of patentability” to be present, it is only necessary that:

A. The prior art patents and/or printed publications raise a substantial question of patentability regarding at least one claim, i.e., the teaching of the (prior art) patents and printed publications is such that a reasonable examiner would consider the teaching to be

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important in deciding whether or not the claim is patentable; it is not necessary that the prior art establish a prima facie case of unpatentability; and

B. The same question of patentability as to the claim has not been decided by the Office in a previous examination or pending reexamination of the patent or in a final holding of invalidity by the Federal Courts in a decision on the merits involving the claim.

For any reexamination ordered on or after November 2, 2002, reliance on previously cited/considered art, i.e., "old art," does not necessarily preclude the existence of a substantial new question of patentability (SNQ) that is based exclusively on that old art. Rather, determinations on whether a SNQ exists in such an instance shall be based upon a fact-specific inquiry done on a case-by-case basis. See MPEP 2242.

If a substantial new question of patentability is found as to one claim, all claims will be reexamined during the ex parte reexamination process. See MPEP 2216.

Discussion of the Cited references

10. ***Sakakida I*** raises a substantial new question of patentability as to claims 1-74 of the Heller patent.

Sakakida discloses a ferrocene-mediated needle-type glucose sensor wherein glucose oxidase (redox enzyme) and ferrocene carboxaldehyde (redox compound) were immobilized to cellulose diacetate (a polymer) on the platinum electrode. The surface of the sensor was covered with a glucose flux-limiting hydrophobic polyurethane membrane and a biocompatible hydrophilic polyvinyl alcohol membrane (page 319, Materials and Methods; page 320, Fig. 1). The oxygen tension does not affect the output current in the ferrocene-mediated glucose sensor (page 321, 3.1). Furthermore, it requires only one point in situ calibration (page 319, abstract).

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There is a substantial likelihood that a reasonable examiner would consider this teaching important in deciding whether or not the claims are patentable. This reference was cited, but was not applied, during the prosecution of the application which became the Heller patent. It is now being viewed in a new light or in different ways. Accordingly, this reference raises a substantial new question of patentability as to claims 1-74, which question has not been decided in a previous examination of the Heller patent.

11. ***Sternberg*** raises a substantial new question of patentability as to claims 1-74 of the Heller patent.

Sternberg discloses a multilayer needle-type enzyme-based glucose microsensor. More specifically, glucose oxidase (redox enzyme) covalently coupled to a cellulose acetate layer, using bovine serum albumin and parabenzoquinone (redox compound) is deposited on the platinum electrode. The sensor is covered with an outer layer of polyurethane (page 27, abstract; page 29, Fig. 1).

There is a substantial likelihood that a reasonable examiner would consider this teaching important in deciding whether or not the claims are patentable. This reference was cited, but was not applied, during the prosecution of the application which became the Heller patent. It is now being viewed in a new light or in different ways. Accordingly, this reference raises a substantial new question of patentability as to claims 1-74, which question has not been decided in a previous examination of the Heller patent.

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12. *Schichiri* together with Sakakida (paragraph 10 above) raise a substantial new question of patentability as to claims 1-74 of the Heller patent.

Schichiri teaches that polyethylene oxide (PEO) membrane is a biocompatible membrane comparable to polyvinyl alcohol membrane. PEO membrane has the in vivo characteristics that its strength of membrane is excellent and the sensor output is good (page 312, Table 2).

There is a substantial likelihood that a reasonable examiner would consider Schichiri's teaching together with the teaching of Sakakida important in deciding whether or not the claims are patentable. Schichiri was not cited during the prosecution of the application which became the Heller patent. Accordingly, Schichiri together with Sakakida raise a substantial new question of patentability as to claims 1-74, which question has not been decided in a previous examination of the Heller patent.

13. *Wilkins (US 4,986,271)* raises a substantial new question of patentability as to claims 1-74 of the Heller patent.

Wilkins discloses an refillable implantable glucose sensor (Fig. 1) wherein the sensing layer comprises glucose oxidase covalently cross linked to the modified graphite (column 4, Example 1) or an electrically conducting polymer (column 4, lines 1-4). The sensing layer is in contact with the working metal electrode (column 3, line 50).

There is a substantial likelihood that a reasonable examiner would consider this teaching important in deciding whether or not the claims are patentable. This reference was cited, but was not applied during the prosecution of the application which became the Heller patent. It is now being viewed in a new light or in different ways. Accordingly, this reference raises a substantial

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new question of patentability as to claims 1-74, which question has not been decided in a previous examination of the Heller patent.

14. ***Sakakida II*** discloses a ferrocene-mediated needle-type glucose sensor wherein glucose oxidase (redox enzyme) and ferrocene carboxaldehyde (redox compound) were immobilized to cellulose diacetate (a polymer) on the platinum electrode. The surface of the sensor was covered with a glucose flux-limiting hydrophobic polyurethane membrane and a biocompatible hydrophilic polyvinyl alcohol membrane (page 147, Fig 1).

There is a substantial likelihood that a reasonable examiner would consider this teaching important in deciding whether or not the claims are patentable. This reference was not cited during the prosecution of the application which became the Heller patent. Accordingly, this reference raises a substantial new question of patentability as to claims 1-74, which question has not been decided in a previous examination of the Heller patent.

Extensions of Time

15. Extensions of time under 37 CFR 1.136(a) will not be permitted in these proceedings because the provisions of 37 CFR 1.136 apply only to "an applicant" and not to parties in a reexamination proceeding. Additionally, 35 U.S.C. 305 requires that *ex parte* reexamination proceedings "will be conducted with special dispatch" (37 CFR 1.550(a)). Extensions of time in *ex parte* reexamination proceedings are provided for in 37 CFR 1.550(c).

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Future Amendment

16. Patent owner is notified that any proposed amendment to the specification and/or claims in this reexamination proceeding must comply with 37 CFR 1.530(d)-(j), must be formally presented pursuant to 37 CFR 1.52(a) and (b), and must contain any fees required by 37CFR 1.20(c).

Future Correspondence

17. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Evelyn Huang whose telephone number is 571-272-0686. The examiner can normally be reached on Tuesday-Friday.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Deborah Jones can be reached on 571-272-1535. The fax phone number for the organization where this application or proceeding is assigned is 571-273-9900.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR

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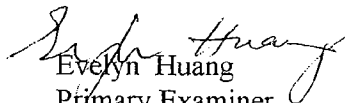
system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

All correspondence relating to this ex parte reexamination proceeding should be directed:

By Mail to: Mail Stop ex parte Reexam
Central Reexamination Unit
Office of Patent Legal Administration
United States Patent & Trademark Office
P.O. Box 1450
Alexandria, VA 22313-1450

By FAX to: 571-273-9900
Central Reexamination Unit

By Hand to: Customer Service Window
Randolph Building
401 Dulany St.
Alexandria, VA 22314


Evelyn Huang
Primary Examiner
Art Unit 3991

Conferee

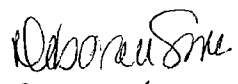
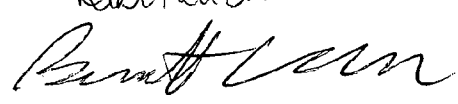



EXHIBIT 5



US006175752B1

(12) **United States Patent**
Say et al.

(10) **Patent No.:** **US 6,175,752 B1**
 (45) **Date of Patent:** **Jan. 16, 2001**

(54) **ANALYTE MONITORING DEVICE AND METHODS OF USE**

4,098,574 7/1978 Dappen .
 4,100,048 7/1978 Pompei et al. .

(List continued on next page.)

(75) Inventors: **James Say**, Alameda; **Michael F. Tomasco**, Cupertino, both of CA (US); **Adam Heller**, Austin, TX (US); **Yoram Gal**, Kibbutz Yagur (II.); **Behrad Aria**, Alameda, CA (US); **Ephraim Heller**, Oakland, CA (US); **Phillip John Plante**, Sunnyvale, CA (US); **Mark S. Vreeke**, Alameda, CA (US); **Keith A. Friedman**, Austin, TX (US); **Fredric C. Colman**, Berkeley, CA (US)

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(List continued on next page.)

(73) Assignee: **Therasense, Inc.**, Alameda, CA (US)

(*) Notice: Under 35 U.S.C. 154(b), the term of this patent shall be extended for 0 days.

(21) Appl. No.: **09/070,677**

(22) Filed: **Apr. 30, 1998**

(51) Int. Cl.⁷ **A61B 5/05**

(52) U.S. Cl. **600/345; 600/365; 128/903**

(58) Field of Search 600/300-301,
 600/346, 306-309, 345-365, 372, 385-390;
 604/174-180; 128/897-898, 903, 904, 920

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Primary Examiner—Cary O'Connor

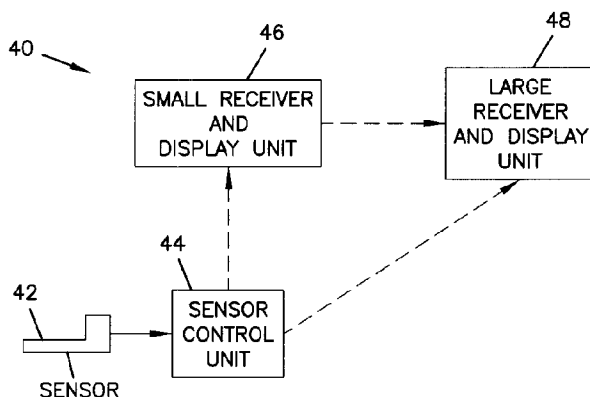
Assistant Examiner—Michael Astorino

(74) *Attorney, Agent, or Firm*—Merchant & Gould P.C.

(57) **ABSTRACT**

An analyte monitor includes a sensor, a sensor control unit, and a display unit. The sensor has, for example, a substrate, a recessed channel formed in the substrate, and conductive material disposed in the recessed channel to form a working electrode. The sensor control unit typically has a housing adapted for placement on skin and is adapted to receive a portion of an electrochemical sensor. The sensor control unit also includes two or more conductive contacts disposed on the housing and configured for coupling to two or more contact pads on the sensor. A transmitter is disposed in the housing and coupled to the plurality of conductive contacts for transmitting data obtained using the sensor. The display unit has a receiver for receiving data transmitted by the transmitter of the sensor control unit and a display coupled to the receiver for displaying an indication of a level of an analyte. The analyte monitor may also be part of a drug delivery system to alter the level of the analyte based on the data obtained using the sensor.

94 Claims, 26 Drawing Sheets



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EXHIBIT 6

US006284478B1

(12) **United States Patent**
Heller et al.(10) **Patent No.:** **US 6,284,478 B1**(45) **Date of Patent:** ***Sep. 4, 2001**(54) **SUBCUTANEOUS GLUCOSE ELECTRODE**3,979,274 9/1976 Newman 435/14
4,008,717 2/1977 Kowarski 435/14(75) Inventors: **Adam Heller; Michael V. Pishko**, both
of Austin, TX (US)

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(73) Assignee: **E. Heller & Company**, Alameda, CA
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(*) Notice: This patent issued on a continued prosecution application filed under 37 CFR 1.53(d), and is subject to the twenty year patent term provisions of 35 U.S.C. 154(a)(2).

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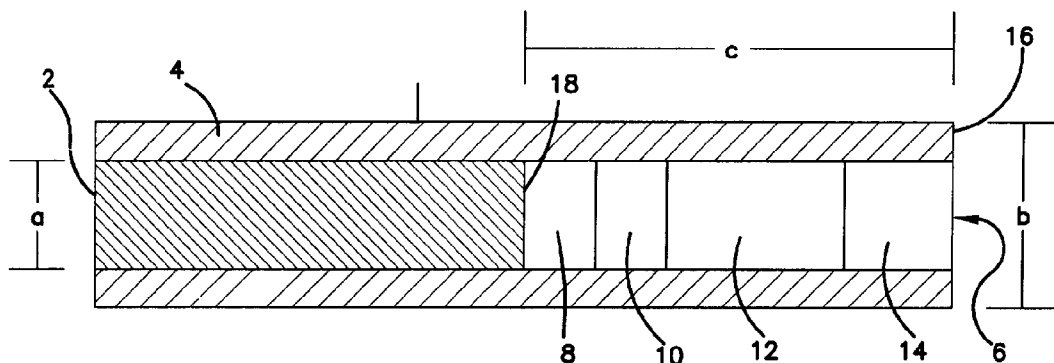
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Related U.S. Application Data

(63) Continuation of application No. 08/299,526, filed on Sep. 1, 1994, now Pat. No. 5,593,852, which is a continuation-in-part of application No. 08/161,682, filed on Dec. 2, 1993, now Pat. No. 5,356,786.

Primary Examiner—Louise N. Leary(74) *Attorney, Agent, or Firm*—Merchant & Gould P.C.(51) **Int. Cl.**⁷ **C12Q 1/54**; C12Q 1/00;
C12Q 1/26; C12Q 1/28(57) **ABSTRACT**(52) **U.S. Cl.** **435/14**; 435/4; 435/25;
435/28; 435/817; 435/287; 436/63; 436/149;
204/403

A small diameter flexible electrode designed for subcutaneous in vivo amperometric monitoring of glucose is described. The electrode is designed to allow "one-point" in vivo calibration, i.e., to have zero output current at zero glucose concentration, even in the presence of other electroactive species of serum or blood. The electrode is preferably three or four-layered, with the layers serially deposited within a recess upon the tip of a polyamide insulated gold wire. A first glucose concentration-to-current transducing layer is overcoated with an electrically insulating and glucose flux limiting layer (second layer) on which, optionally, an immobilized interference-eliminating horseradish peroxidase based film is deposited (third layer). An outer (fourth) layer is biocompatible.

(58) **Field of Search** 435/4, 14, 25,
435/28, 817, 287; 436/63, 149; 204/403(56) **References Cited****U.S. PATENT DOCUMENTS**Re. 32,947 6/1989 Dormer et al. 435/14
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